

The opinion in support of the decision being entered today was **not** written for publication and is **not** binding precedent of the Board.

Paper No. 17

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DOREEN M. TUTTLE

Appeal No. 2001-0711
Application No. 09/097,398

ON BRIEF

Before FLEMING, DIXON, and GROSS, **Administrative Patent Judges**.
DIXON, **Administrative Patent Judge**.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1-8,
which are all of the claims pending in this application.

We AFFIRM-IN-PART.

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BACKGROUND

The appellant's invention relates to an automated skill program. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced below.

1. A method of generating reports furnishing data from which to assess comparative technical skills of employees of an organization having departments respectively in charge of performing different missions, including the steps of: initially entering collected personnel information in sequence with respect to said employees respectively identified by social security numbers; storing said collected personnel information as employee identified data within tables under a plurality of different skill influencing categories; coding the employee identified data within said tables in accordance with directorate code numbering of said departments and administrative code numbering related to experiences of the employees, said missions and numerical values assigned to skill levels associated with the technical skills of the employees evaluated from the personnel information respectively collected under the different skill influencing categories; and extracting reports from the tables under selected categories of the collected personnel information following said storing and said coding thereof.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Clark et al. (Clark)	5,164,897	Nov. 17, 1992
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Claims 1-8 stand rejected under 35 U.S.C. § 103 as being unpatentable over

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Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellant regarding the above-noted rejections, we make reference to the examiner's answer (Paper No. 14, mailed Aug. 14, 2000) for the examiner's reasoning in support of the rejections, and to the appellant's brief (Paper No. 13, filed May 10, 2000) and reply brief (Paper No. 15, filed Aug. 24, 2000) for the appellant's arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellant's specification and claims, to the applied prior art references, and to the respective positions articulated by the appellant and the examiner. As a consequence of our review, we make the determinations which follow.

At the outset, we note that appellant has elected to group the claims into three separate groupings. (See brief at page 3.) We do not understand how claims 1-6 can be grouped together while claims 1-4 are being grouped together at the same time. Therefore, we will address claims 1-6 together as a group and address claims 7 and 8 together as a group.

Furthermore, we find that the examiner has addressed the language of claims

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modifying the teachings of Clark. Therefore, we find that the examiner has established a ***prima facie*** case of obviousness with respect to the rejection under 35 U.S.C. § 103, and the burden shifts to appellant to rebut the ***prima facie*** case.

Appellant argues that the examiner relies upon hindsight speculation which does not amount to factual finding for obviousness. (See brief at pages 3-4.) We disagree with appellant. Appellant argues that the content of claim 1, lines 1-3, and claims 7 and 8, are not taught by column 2 of Clark. (See brief at page 4.) Appellant argues that the teaching of Clark at column 2 that “[o]ne embodiment of the method of the invention further includes a means for printing out a summary report of all candidates stored in the system according to job title and/or special classifications, number of candidates available and billing rates” does not explicitly or inherently refer to “departments of an employment organization, respectively in charge of performing different missions such as maintenance, alternation [sic, alteration] and modernization of a sea-going vessel.” (See brief at page 4.) We do not find the limitations as argued to be well supported by the language of independent claim 1. Therefore, this argument is not persuasive. First the language of claim 1 does not recite an “employment organization,” nor does it

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code not previously assigned. (See brief at page 4.) The examiner acknowledges this difference in the rejection and maintains that it would have been obvious to one of ordinary skill in the art at the time of the invention to use the SSN since it was a well known and established practice to use an individual's SSN in educational institutions, banks, etc. for the purpose of identification. (See answer at page 5.) We agree with the examiner. From our review of the teachings of Clark, Clark teaches:

In the example embodiment of the method of the invention, the job title code data file 10 includes job title codes and corresponding employee code numbers. The employee code numbers are, for example, five digit logical numerical count numbers which are unique to each individual or potential employee for whom data is stored in the system database. There may be several job title codes stored in the job title code data file for each employee code depending on the job experience of the particular employee. The job title codes may be a width of about 9 characters and are preferably based upon the pre-assigned codes as cataloged in the Dictionary of Occupational Titles as published by the United States Department of Labor Employment and Training Administration. While it is possible to create job title codes based upon an independent, logical numbering system, it is preferable in the United States to use the pre-existing codes in the Dictionary of Occupational Titles. Modifications to these codes may be made as deemed appropriate by the user of the automated method of the invention. (See column 5, line 53 thru column 6, line 5. Emphasis added)

Here, we note the teaching with respect to the job codes being pre-existing and the desire for unique identification of the individual would have suggested the use of the

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additional work thereby making it desirable. In view of the above discussion, we agree with the examiner that it would have been obvious to one of ordinary skill in the art at the time of the invention to use the individual's SSN for the purpose of identification.

Appellant argues that claims 1 and 5 call for "extracting reports from - - selected categories of the collected personnel information- -." (See brief at page 5.) Appellant argues that Clark clearly fails to explicitly disclose extraction of reports from selected categories. Instead the portion of Clark referenced by the examiner refers to printing out a summary report of all candidates. (See brief at page 5.) We disagree with appellant. While the examiner refers to the printing out of the summary report of all candidates in column 2, when taken in combination with the earlier discussion in column 2 at lines 3-29 concerning employee records having qualifications matching at least first predetermined set of first, second and third job criteria, we find that Clark teaches or fairly suggest extraction of reports from selected categories. Clark further discloses at column 2, lines 49-50 that the data is for "eventual display or printout to the user." Therefore, it would have been readily apparent to skilled artisans that these matches and the results of searches would have been extraction of reports to be conveyed to the user in some tangible form. Therefore, this argument is not

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Appellant argues that Clark does not teach the limitation of organizational departments having different missions and that the limitation is not obvious from Clark without hindsight. (See reply brief at page 2.) We disagree with appellant and find that the examiner's discussion of an organization at pages 10-11 of the answer is generally correct. We clarify that the examiner's use of the term "inherently" may be a slight overstatement, but we agree that it would have been readily apparent to one of ordinary skill in the art at the time of the invention that it was well known in a business environment that stores and businesses are quite commonly organized into multiple departments and each of these departments would have had a separate yet related mission to the overall operation of the good of the organization. Additionally, the examiner maintains that the storage of the various specific job titles in the data files evidences the specific organizational departments which would have differing missions. (See answer at page 11.) We agree with the examiner that the various job titles evidence a wide range of job functions and areas within an organization.

With respect to the use of the SSN, appellant argues that the use of SSN avoids the creation of a new code and serves the additional purposes involving extraction of certain employee personnel information such as veterans' preference and reservist

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Appellant argues a distinction between In re McLaughlin, 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971) and In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177-78 (CCPA 1967). We find no distinction between the two cases whereas both stand for the premise that any examination inherently involves a reading of the application and evaluation which must involve some hindsight in the evaluation, as long as it does not reach the level on impermissible reconstruction where the round peg is forced into the square hole without some motivation to do so. Here, as discussed above, we agree with the examiner that there is ample suggestion for one of ordinary skill in the art to find the invention as recited in claim 1 to have been obvious in view of the teachings of Clark. Therefore, we find that appellant has not adequately rebutted the ***prima facie*** case of obviousness with respect to independent claim 1 and dependent claims 2-6, and we will sustain the rejection thereof.

With respect to dependent claims 7 and 8 we reach the opposite conclusion. Appellant argues that Clark does not explicitly or inherently refer to “departments of an employment organization, respectively in charge of performing different missions such as maintenance, alternation [sic, alteration] and modernization of a sea-going vessel.” (See brief at page 4.) We agree with appellant that Clark does not discuss or suggest

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the use with maintenance, alteration and modernization of a sea-going vessel nor does the examiner provide a convincing line of reasoning why it would have been obvious to one of ordinary skill in the art at the time of the invention to implement the system of Clark for those uses. From our review of the portions of Clark relied upon by the examiner, we find that the examiner has not provided adequate support for the conclusion of obviousness of the claimed use. The mere mention of a category of “ships” in some job criteria does not address the invention as claimed. Therefore, we will not sustain the rejection of claims 7 and 8.

CONCLUSION

To summarize, the decision of the examiner to reject claims 1-6 under 35 U.S.C. § 103 is affirmed, and the decision of the examiner to reject claims 7 and 8 under 35 U.S.C. § 103 is reversed.

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No time period for taking any subsequent action in connection with this appeal
may be extended under 37 CFR § 1.136(a).

AFFIRMED-IN-PART

MICHAEL R. FLEMING
Administrative Patent Judge

JOSEPH L. DIXON
Administrative Patent Judge

ANITA PELLMAN GROSS
Administrative Patent Judge

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